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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,545	03/10/2004	David S. Bonalle	54022.1200	2544

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EXAMINER	
FRENEL, VANEL	

ART UNIT	PAPER NUMBER
3687	

MAIL DATE	DELIVERY MODE
05/12/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/708,545	BONALLE ET AL.	
	Examiner	Art Unit	
	VANEL FRENEL	3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 August 2008*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed on 8/12/08. Claims 1-19 have been cancelled. Claims 20-35 have been newly added. Claims 20-35 are pending.

2. Applicant's has called on 4/27/09 the Examiner by indicating that the limitations of " denying said transaction request in response to said transactions counted value exceeding a maximum transactions value "have not been addressed. The Examiner after further review the application has seen that Applicant arguments have been persuasive; therefore the previous Office Action is withdrawn and a new Office Action is hereby forth coming.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 20-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20-35 recite a process comprising the steps of: receiving and denying. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parkerv. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurta et al. (6,317,721)in view of Anderson et al. (6,608,551).

As per claim 20, Hurta discloses a method comprising: receiving a transaction request from an RF transaction device (See Hurta, Co1.5, lines 49-58; Co1.7, lines 43-55).

Hurta does not explicitly disclose wherein said transaction request comprises a transactions counted value; and denying said transaction request in response to said transactions counted value exceeding a maximum transactions value.

However, these features are known in the art, as evidenced by Anderson. In particular, Anderson suggests wherein said transaction request comprises a transactions counted value (See Anderson, Co1.3, lines 1-42; Co1.5, lines 21-54); and denying said transaction request in response to said transactions counted value exceeding a maximum transactions value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Anderson within the system of Hurta with the motivation of providing a wireless data communications system which includes at least one portable device, such as a wireless data collection terminal, which is equipped with

a programmable RFID tag (See Anderson, Co1.1, lines 46-48).

As per claim 21, Hurta discloses the method wherein said transaction request further comprises at least one of an RF transaction device authentication tag, an account issuer routing number, or an encrypted transaction device identifier (See Hurta, Co1.3, lines 1-12; Co1.5, lines 1-25).

As per claim 22, Hurta discloses the method further comprising transmitting an interrogation signal to said RF transaction device (See Hurta, Co1.6, lines 15-46).

As per claim 23, Anderson discloses the method further comprising: transmitting said transaction request to a transaction processing entity (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46); and receiving a denial message from said transaction processing entity in response to said transactions counted value exceeding said maximum transactions value (See Anderson,Fig.3; Fig.4; Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

As per claim 24, Anderson discloses the method further comprising disabling said RF transaction device in response to said transactions counted value exceeding said maximum transactions value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

As per claim 25, Anderson discloses the method further comprising: presetting said transactions counted value to an initial count value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46); setting an increment value for said transactions counted value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46); and setting said maximum transactions value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

As per claim 26, Hurta discloses a radio frequency identification (RFID) reader comprising: a transponder for receiving a transaction request from an RF transaction device (See Hurta, Col.3, lines 30-50).

Hurta does not explicitly disclose wherein said transaction request comprises a transactions counted value; and a network device for denying said transaction request in response to said transactions counted value exceeding a maximum transactions value.

However, these features are known in the art, as evidenced by Anderson. In particular, Anderson suggests wherein said transaction request comprises a transactions counted value (See Anderson, Col.5, lines 21-54; Fig.4; Col.5, lines 38-46); and a network device for denying said transaction request in response to said transactions counted value exceeding a maximum transactions value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Anderson within the system of Hurta with the

motivation of providing a wireless data communications system which includes at least one portable device, such as a wireless data collection terminal, which is equipped with a programmable RFID tag (See Anderson, Co1.1, lines 46-48).

As per claim 27, Anderson discloses the RFID reader further comprising: means for receiving at least one of a transaction device authentication tag or an encrypted transaction device identifier from said RF transaction device (See Anderson, Co1.4, lines 20-47); and means for decrypting said encrypted transaction device identifier to authenticate said RF transaction device (See Anderson, Co1.4, lines 20-40).

As per claim 28, Hurta discloses a transaction processing entity comprising: means for receiving a transaction request from an RF transaction reader, wherein said transaction request is initiated by an RF transaction device (See Hurta, Co1.3, lines 30-50).

Hurta does not explicitly disclose wherein said transaction request comprises a transactions counted value; and means for denying said transaction request in response to said transactions counted value exceeding a maximum transactions value.

However, these features are known in the art, as evidenced by Anderson. In particular, Anderson suggests wherein said transaction request comprises a transactions counted value (See Anderson, Co1.3, lines 1-42; Co1.5, lines 21-54); and means for denying said transaction request in response to said transactions counted

value exceeding a maximum transactions value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Anderson within the system of Hurta with the motivation of providing a wireless data communications system which includes at least one portable device, such as a wireless data collection terminal, which is equipped with a programmable RFID tag (See Anderson, Co1.1, lines 46-48).

As per claim 29, Anderson discloses the transaction processing entity wherein said transaction request further comprises at least one of an RFID reader authentication tag, an RF transaction device authentication tag, or an encrypted transaction device identifier (See Anderson, Fig.1; Co1.3, lines 1-10).

As per claim 30, Anderson discloses the transaction processing entity further comprising means for validating said RF transaction device in accordance with said RF transaction device authentication tag (See Anderson, Co1.4, lines 20-38).

As per claim 31, Anderson discloses the transaction processing entity of claim 28, further comprising means for evaluating validity of said RFID reader in accordance with said RFID reader authentication tag (See Anderson, Co1.2, lines 5-29).

As per claim 32, Anderson discloses a method comprising: transmitting a transaction request to an RFID reader (See Hurta, Co1.3, lines 30-50).

Hurta does not explicitly disclose wherein said transaction request comprises a transactions counted value, and wherein said transaction request is denied in response to said transactions counted value exceeding a maximum transactions value; and incrementing, at said RF transaction device, said transaction counted value.

However, these features are known in the art, as evidenced by Anderson. In particular, Anderson suggests wherein said transaction request comprises a transactions counted value, and wherein said transaction request is denied in response to said transactions counted value exceeding a maximum transactions value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46); and incrementing, at said RF transaction device, said transaction counted value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Anderson within the system of Hurta with the motivation of providing a wireless data communications system which includes at least one portable device, such as a wireless data collection terminal, which is equipped with a programmable RFID tag (See Anderson, Co1.1, lines 46-48).

As per claim 33, Anderson discloses the method further comprising incrementing said transactions counted value by a predetermined value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

As per claim 34, Anderson discloses the method further comprising incrementing said transactions counted value in response to at least one of receiving an interrogation signal, transmitting data, or completing an RF transaction (See Anderson, Co1.2, lines 5- 29).

As per claim 35, Anderson discloses a Radio Frequency (RF) transaction device comprising: means for transmitting a transaction request to an RF Identification (RFID) reader (See Hurta, Co1.3, lines 30-50).

Hurta does not explicitly disclose said transaction request comprising a transactions counted value, wherein said transaction request is denied in response to said transactions counted value exceeding a maximum transactions value; and means for incrementing, at said RF transaction device, said transactions counted value.

However, these features are known in the art, as evidenced by Anderson. In particular, Anderson suggests said transaction request comprising a transactions counted value, wherein said transaction request is denied in response to said transactions counted value exceeding a maximum transactions value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46); and means for incrementing, at said RF transaction device, said transactions counted value (See Anderson, Co1.5, lines 21-54; Fig.4; Co1.5, lines 38-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Anderson within the system of Hurta with the

motivation of providing a wireless data communications system which includes at least one portable device, such as a wireless data collection terminal, which is equipped with a programmable RFID tag (See Anderson, Co1.1, lines 46-48).

Response to Arguments

6. Applicant's arguments filed on 8/12/08 with respect to claims 20-35 have been fully considered but they are not persuasive.

(A) At pages 1-3 of the response filed on 8/12/08, Applicant argues the followings:

(i) receiving a transaction request from an RF transaction device, wherein said transaction request comprises a transactions counted value; and denying said transaction request in response to said transactions counted value exceeding a maximum transactions value.

(ii) Hurta and Anderson fail to teach the limitations of claims 20-35. Therefore, claims 20-35 should be allowed.

(B) With respect to Applicant's first argument, the Examiner respectfully submitted that He relied upon the teaching of Anderson (See Co1.3, lines 1-42; Co1.5, lines 21-54) which correspond to Applicant claim feature. Therefore, Applicant's argument is not

persuasive and the rejection is hereby sustained.

(C) With respect to Applicant's second argument, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention.

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111 (b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. In re Cole, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); In re Schulze, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716

(1965); Mertizner v, Mindick, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in In re DeLisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in In re Lamberti et al, 192 USPQ 278 (CCPA) that:

(i) obviousness does not require absolute predictability;

(ii) non-preferred embodiments of prior art must also be considered; and

(iii) the question is not express teaching of references, but what they would suggest. Therefore, Applicant's argument is not persuasive and the rejection is hereby sustained.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nanel Frenel/

Examiner, Art Unit 3687

May 10, 2009